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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,727	07/29/2003	Guy B. Olney	7784-000650	7519

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EXAMINER

JARRETT, SCOTT L

ART UNIT	PAPER NUMBER
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3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/629,727	Applicant(s) OLNEY ET AL.	
	Examiner Scott L. Jarrett	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's submission filed July 29, 2003. Currently Claims 1-25 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as currently recited, appear to be directed to a compilation of data without any tangible result and are therefore deemed to be non-statutory while the compilation of data may have some real world value (i.e. utility/usefulness) there is no requisite functionality present to satisfy the practical application requirement nor are there any "acts" which transform the data and/or cause a physical transformation to occur outside the computer (i.e. not concrete or tangible) therefore the invention as claimed does not produce a useful, concrete, and tangible result.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does

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not make it statutory. See *Diamond v. Diehr*, 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In *re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (*Abele*, 684 F.2d 902, 907, 214 USPQ 682, 687 (CCPA 1982)). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

A claimed invention is deemed to be statutory, if the claimed invention produces a useful, concrete, and tangible result. An invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible"-Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

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In the present case, claims 1-25 merely recite a method and system for modeling computer support services wherein the modeling merely involves collecting a plurality of data related to computer support (i.e. useful and concrete). While the invention may be concrete and/or useful, there does not appear to be any tangible result.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14 and 16-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowman-Amuah, U.S. Patent No. 6,256,773.

Regarding Claims 1, 4 and 16 Bowman-Amuah teaches a system and method of managing computer support services and process comprising (Column 15, Lines 41-68; Column 16, Lines 1-11):

- defining a computer support service as one of a computing transaction and a change to a computing environment (Column 2, Lines 19-43; Column 3, Lines 7-58; Column 18, Lines 43-54; Column 20, Lines 18-43);

- a computer support process comprising:

- an information delivery process, for delivery computing transactions (Column 11, Lines 50-68; Column 18, Lines 23-39);
- an environment build process for delivering changes to a computing environment (release management, build, migration, etc.; Column 13, Lines 47-68; Column 14, Lines 11-29; Column 33, Lines 1-27; Column 34, Lines 53-68); and

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- a find/fix process for finding service and process defects associated with the information delivery and/or environment build processes (quality, failure, problem, incident, change management; Column 12, Lines 61-68; Column 14, Lines 29-40; Column 26, Lines 44-68; Column 27, Lines 27-68; Column 28, Lines 1-68; Column 33, Lines 1-27; Column 34, Lines 17-53; Column 110, Lines 31-68);
- managing the quality of information about the processes (information delivery, environment build, find/fix; Column 22, Lines 37-68; Column 23, Lines 23-68; Column 31, Lines 1-52; Column 56, Lines 11-52).

Regarding Claims 2-3 and 19-20 Bowman-Amuah teaches a system and method for managing computer support services wherein the computing support process includes defining lower-level computer support processes as a part of the information delivery, environment build and find/fix processes and as one of a computer transaction and a change to a computing environment (Column 16, Lines 46-68; Column 17, Lines 23-30; Column 24, Lines 14-38).

Regarding Claims 5, 17 and 24 Bowman-Amuah teaches a system and method for managing computer support services wherein the find/fix process further includes corrective action, data analysis and preventative action (Column 20, Lines 19-52; Column 23, Lines 3-68; Column 31, Lines 1-51; Column 33, Lines 29-68; Column 34, Lines 1-16; Column 56, Lines 22-52).

Regarding Claims 6-7 Bowman-Amuah teaches a system and method for managing computer support services wherein the correction action includes service restoration and/or defect management (Column 27, Lines 29-68; Column 28, Lines 1-27; Column 31, Lines 30-51; Column 110, Lines 31-68; Column 111, Lines 1-68; Column 112, Lines 1-33).

Regarding Claims 8-9 Bowman-Amuah teaches a system and method for managing computer support services wherein data analysis includes analyzing data generated by corrective and/or preventative data and the data includes quality, cycle time, unit cost, reactive trends or productivity data (Column 23, Lines 16-68; Column 24, Lines 1-14; Column 31, Lines 30-51).

Regarding Claim 10 Bowman-Amuah teaches a system and method for managing computer support services wherein the preventive action includes root cause analysis (Column 23, Lines 4-45).

Regarding Claims 11-12, 18 and 25 Bowman-Amuah teaches a system and method for managing computer support services further comprising continually process improving including a change management process for change a process/product;

- advising a supplier of a defective product (quality, failure, problem, incident,

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change management; Column 27, Lines 29-44; Column 30, Lines 45-68; Column 34, Lines 17-53; Column 42, Lines 11-50);

- receiving an improved product from the supplier (developer; Column 27, Lines 29-44; Column 30, Lines 45-68; Column 34, Lines 17-53; Column 42, Lines 11-50); and

- installing the improved product to the computing environment through the environment build process (Column 27, Lines 29-68; Column 28, Lines 1-38)

Regarding Claim 13 Bowman-Amuah teaches a system and method for managing computer support services further comprising generating a record (Column 109, Lines 30-68).

Regarding Claim 14 Bowman-Amuah teaches a system and method for managing computer support services wherein the find/fix process includes an infrastructure performance management process (Column 33, Lines 29-68; Column 34, Lines 1-16; Column 67, Lines 1-8).

Regarding Claim 21, claim 21 recites similar limitations to Claims 1-3 and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1-3.

Regarding Claim 22 Bowman-Amuah teaches a system and method for managing computer support services wherein the information delivery process is

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generally automated and transparent to the end users (Column 29, Lines 55-68;
Column 52, Lines 23-63).

Regarding Claim 23 Bowman-Amuah teaches a system and method for
managing computer support services wherein a change to the computing environment
includes one or more hardware, software, data, user or computing environment change
(Column 23, Lines 43-68).

Claim Rejections - 35 USC § 103

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman-Amuah, U.S. Patent No. 6,256,773 as applied to claims 1-14 and 16-25 above.

Regarding Claim 15 Bowman-Amuah teaches the utilization of industry standards and procedures wherein "Well documented, comprehensive standards make designers more independent and enable them to product more consistent, high quality designs." (Column 36, Lines 60-64)

Bowman-Amuah does not expressly teach that one of the computer support services further comprises at least one computer support process as defined by the Information Technology Infrastructure Library taxonomy as claimed.

Official noted is taken that it is a common and well known business practice to utilize computer support services as defined by the Information Technology Infrastructure Library taxonomy in the management of computer support services and processes, accordingly it would have been obvious to one skilled in the art at the time of the invention that the system and method for managing computer support services and processes as taught by Bowman-Amuah would have benefited from utilizing any of a plurality of well known computer support standards including but not limited to computer support process as defined by the Information Technology Infrastructure Library taxonomy; the resultant system/method enabling users to build and deliver more

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consistent and higher quality products/support services (Bowman-Amuah: Column 36, Lines 60-64).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- McFarland, U.S. Patent No. 6,154,753, teaches a system and method for enabling "organizations to carry on its business activities in accordance with the requirements of quality standards."

- Riley et al., U.S. Patent Publication No. 2002/0123983, teach a service desk management system and method.

- InteQ Announces IT Service Management Best Practices Series (1999), teach the availability of training courses for utilizing the Information Technology Infrastructure Library to manage computer support services. The article further teaches that "Considered a de-facto standard for IT Service Management, ITIL is practiced by organizations worldwide."

- Greiner, Pink Elephant Leads Quiet Stampede to ITIL (2000), teaches the widespread use of ITIL wherein ITIL was developed in the 1980's by the British government based on work done at IBM 10 year's earlier.

- Kumar, Managing Changes in Large Programs (2000), teaches a method for managing computer support services comprising information delivery, environment build and find/fix processes.

- National Organization ITMSI Bring InteQ's Web-based IT Best Practices Training Course to North American Customers (2001), teaches The Information

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Technology Service Management Institute (ITMSI) promotion of IT best practices for continual process improvement.

- Dubie, Remedey, Peregrine release help desk software (2003), teach a commercially available computer services support system and method that utilizes/includes ITIL best practices.

- Peregrine Systems' ServiceCenter 5.1 and 5.0 Complete ITIL Certification (2003), teaches a commercially available computer services support system and method that utilizes ITIL best practices and includes service support in four areas: incident, problem, change and configuration management.

- IBM and the IT Infrastructure Library (2003), teaches IBM's utilizing of ITIL to manage computer support services.

- Best Practice for Service Support (2000), teaches a plurality of well known ITIL best practices for service support management including configuration management, change management, release management, incident management, problem management, service desk, environmental infrastructure processes and service management.

- Wikipedia.org web pages teach Information Technology Infrastructure and IT Service Management history and definitions.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (571) 272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Scott Jarrett
Asst. Examiner
June 19, 2007